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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,869	07/22/2003	Theodore G. Duclos	99-0033/COA	7658

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FREUDENBERG-NOK GENERAL PARTNERSHIP
INTELLECTUAL PROPERTY DEPT.
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER

KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,869

Applicant(s)

DUCLOS ET AL.

Examiner

Michael J Kyle

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07232003
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the limitation “relatively thin”. It is unclear what this is relative too, and what is encompassed by the term “relatively”. For the purpose of this Office Action, examiner considers any thickness to be relatively thin.
2. Claim 11 is objected because of the limitation, “said elastomeric sealing members has a cure system”. It appears that a cure system is a process. It is therefore unclear how a sealing member can physically *have* a claimed process. Examiner believes the sealing member is made from, or formed by, the claimed process.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7-11, 14, 17-19, 21, 22, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Creavey (U.S. Patent No. 3,033,582). With respect to claims 1, 7, 10, 17, 18, and 25, Creavey discloses a static gasket sealing between first (21) and second (20) sealing surfaces that are secured together. Creavey also discloses a thin carrier member (11), a first stopper member (15), second stopper member (16), a cavity formed between the stopper members, and the stopper members having a height above the top surface of the carrier member. The second

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stopper member (17) has a height greater than that of the first stopper member (16). Creavey further discloses an elastomeric seal member (17) inside the cavity, having a sealing bead with an apex greater than the height of the first and second stoppers. The apex is adapted to compress to the height of the first and second stoppers as (shown in figures 3-5), where the stoppers prevent the seal member (17) from being over compressed. Creavey further discloses a second pair of stoppers on an opposite surface (bottom portion of gasket, mirror image stoppers 16, 17), where the stoppers have a height above the opposite surface. Additionally, Creavey shows a second elastomeric sealing member (mirror of 17, bottom portion of gasket in figures 3-5). The second pair of stoppers limits the compression of the second elastomeric sealing members.

5. Examiner notes that are several limitations regarding a method of loading the gasket, or an intended use of the gasket, such as, "A clamp load is applied", and the gasket is "subjected to the clamp load". It is noted that Creavey discloses all of the claimed structural elements, and is capable of being loaded as claimed by applicant. It is further noted that the reactive from the surfaces 20 and 21 of Creavey are identical to the forces that would arise from the clamping forces recited in the claims. Furthermore, the claims are drawn only to the gasket itself. Creavey meets all of the structural limitations of the gasket.

6. With respect to claims 2-4, Creavey discloses the sealing bead to be a triangle, the volume of the cavity is greater than the volume of the elastomeric seal member, and the elastomeric seal member is formed from a fluorocarbon. U.S. Patent No. 4,460,155 to Smith is cited as an evidentiary reference to show that Teflon (used by Creavey) is a fluorocarbon.

Examiner cites Smith column 3, lines 32-34 to show this.

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7. With respect to claims 8, 9, and 21, Creavey discloses the first and second stopper members (16, 17) are metal, and the apex is compressed 1.5% to 70%.

8. With respect to claims 11 and 19, examiner notes these appear to be a product-by-process claim, where a process of making the product is claimed, in a product claim. Claims 11 and 19 are product claims. As such, only the physical structure of the claim is considered. Any prior art reference that meets the structural limitations is considered to be capable of being made in the claimed manner. Examiner asserts that the elastomeric sealing members of Creavey are capable of being formed from any of the claimed cure systems, and the first stopper member is capable of being molded on the carrier.

9. With respect to claim 14, Creavey's carrier (11) is made of metal.

10. Claims 17 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (U.S. Patent No. 2,513,178). Jackson discloses a static gasket sealing between first and second sealing surfaces comprising a thin carrier (portion between seals 13, in figure 5) with first and second surfaces facing the respective sealing surfaces, and a first stopper member (raised portion to left of 13, in figure 5) with a first height. Jackson further discloses an elastomeric seal (13) formed on the first surface with a height greater than the first height. The elastomeric seal (13) has a thickness greater than that of the carrier.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey. Creavey does not explicitly disclose the stopper members to have a shape factor between .15 and 10. However, since there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. Altering the shape factor of an element is considered to a design choice within the skill of the art.

13. Claims 5, 6, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view of Combet et al ("Combet", U.S. Patent No. 6,390,479). Creavey is silent with regard to the dimensions of the carrier member.

14. Combet teaches a carrier member having a thickness of less than 1.0 mm and the compressed thickness is in the range of 0.015 and 1.75 mm (column 3, line 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to change the thickness of the prior art carrier since such a modification is a design consideration within the skill of the art. In re Rose, 220 F.2d, 105 USPQ 237 (CCPA 1955).

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view of Lucas et al ("Lucas", U.S. Patent No. 4,635,949). Creavey fails to disclose an adhesive layer on the second surface. Creavey fails to disclose an adhesive layer on the second surface of the carrier member.

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16. Lucas teaches a gasket assembly where a seal ring (8) is bonded to the carrier, or sheet, (1) by a heat resistant adhesive. The adhesive positively secures the seal (8) to the carrier (1). It would have been obvious to one having ordinary skill in the art at the time of the invention to positively secure the seal (17) to the carrier member (11) of Creavey. This results in an adhesive layer on the second surface of Creavey.

Response to Arguments

17. Applicant's arguments filed July 22, 2003 have been fully considered but they are not persuasive.

18. Applicant argues the bolt clamping load in Creavey only brings together the pipe flanges and does not compress the gasket. Examiner asserts that where the load is coming (i.e. surrounding structure) from is not an aspect of the present invention as the claims are drawn toward the structure of the gasket assembly. Creavey meets all of the structural limitations of the independent claims regarding. Additionally, the claims recite that a clamping load is "applied", or the gasket is "subjected" to a clamp load. These limitations recite a method of the intended use of the gasket. As long as the prior art is capable of being used for the claimed intended use, then the prior art reads on that aspect of the claim. As such, Creavey's gasket is capable of being subjected to the claimed loads. Examiner supports this by drawing attention to the sequence depicted in Creavey's figure 3-5, where compression of the gasket is shown. While applicant is correct in stating the fluid pressure creates the force, examiner notes that the reactive forces from surfaces 20 and 21 create a clamping force identical to that of the present invention.

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19. Applicant argues that Creavey teaches away from the present invention. Examiner disagrees. Applicant has provided no structural limitations in the claims that differentiate the claimed invention from Creavey. Additionally, there has been no modification to Creavey in the rejection of the independent claims, and Creavey meets every limitation of the claims.

20. Applicant argues the Creavey does not teach the use of an elastomeric material. Examiner disagrees. Creavey teaches the use of Teflon for the seal 17. Firstly, as evidenced by Smith, Teflon is a fluorocarbon, which is one of the claimed elastomeric materials the seal may be made from in the present invention. Secondly, Creavey states that Teflon is used because of its ability to "return to its normal shape after the removal of the pressure" (column 4, lines 9-18). "Elastomer" is defined as "any of various elastic substances resembling rubber" (Merriam-Webster's Collegiate Dictionary, 10th edition). The ability of Teflon to return to its normal shape after is pressure is removed resembles rubber.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art with respect to elastomeric gaskets: Jelinek, Dugge, and Miller.

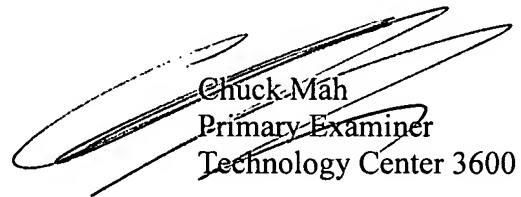
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk



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